

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Re: Appeal to the Board of Patent Appeals and Interferences

In re Application of: JOCHEN KAPPEL et al. Group Art Unit: 2194
Serial No.: 09/823,866 Examiner: S. Lao
Filed: March 31, 2001 Our Customer ID: 22827
For: OBJECT TO OBJECT COMMUNICATIONS Our Account No.: 04-1403
SYSTEM AND METHOD Attorney Ref.: SSM-9.7
Sir:

1. ☐ **NOTICE OF APPEAL:** Pursuant to 37 CFR 41.31, Applicant hereby appeals to the Board of Appeals from the decision dated ____ of the Examiner twice/finally rejecting claims ____.
2. ☒ **BRIEF** on appeal in this application pursuant to 37 CFR 41.37 is transmitted herewith (1 copy)
3. ☐ An **ORAL HEARING** is respectfully requested under 37 CFR 41.47 (due within two months after Examiner's Answer).
4. ☐ Reply Brief under 37 CFR 41.41(b) is transmitted herewith (1 copy).
5. ☐ "Small entity" verified statement filed: ☐ herewith ☐ previously.

6. **FEE CALCULATION:**

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Petition is hereby made to extend the original due date of
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(5 months \$2,160)

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original due date.

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	\$ 620.00

Subtotal	\$ _____
	\$ 620.00

If "small entity" box 5 above is X'd, enter one-half
(1/2 of subtotal and subtract)

TOTAL FEE	\$ 620.00
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- ☒ Fee enclosed.
- ☐ Charge fee to our Deposit Account/Order Nos. in the heading hereof (for which purpose one additional copy of this sheet is attached)
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- ☐ Fee NOT required since paid in prior appeal in which the Board of Appeals did not render a decision on the merits.

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ATTORNEY DOCKET NO.: SSM-9.7

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS AND INTERFERENCES**

In response to:	Application of: Jochen Kappel et al.)	Examiner: Sue X. Lao
)	
Serial No.:	09/823,866)	Group Art Unit: 2194
)	
Filed:	March 31, 2001)	Our Customer ID: 22827
)	
Confirmation No.:	1807)	Our Account No.: 04-1403
)	
For:	Object to Object Communications)	
	System and Method)	

APPEAL BRIEF

Honorable Commissioner for Patents
U.S. Patent and Trademark Office
Post Office Box 1450
Alexandria, VA 22313-1450

Honorable Commissioner:

In response to the July 8, 2005 Office Action for the above-referenced application, Applicants submit herewith this Appeal Brief in triplicate (together with Section xiii: CLAIMS APPENDIX) in accordance with 37 CFR § 41.37 as well as the requisite fee for the subject Appeal Brief as set forth in 37 CFR § 41.20(b)(2). Notice of Appeal was filed on January 6, 2006.

i. REAL PARTY IN INTEREST:

The real party in interest with respect to the above-captioned application and this appeal is an assignee and/or any successor interests thereof, which by assignment recorded on February 13, 2004, at Reel 014981, Frame 0322, is SchlumbergerSema

Telekom GmbH & Co. KG, a corporation duly organized, incorporated and existing under the laws of Germany, having its principal office and place of business at Atrogen Building, Otto-Hahn-Strasse 36, 63303 Dreieich, Germany.

ii. **RELATED APPEALS AND INTERFERENCES:**

Applicant is not aware of any other appeals or interferences that will directly affect or have bearing on the Board's decision on this appeal.

iii. **STATUS OF CLAIMS:**

Present claims 1-22 stand finally rejected. Applicants are appealing the final rejection of such claims 1-22.

iv. **STATUS OF AMENDMENTS:**

Applicant filed an Amendment on June 8, 2005, pursuant to 37 C.F.R. §1.116, in response to a February 8, 2005 "final" Office Action. Such paper presented amendments to claims 1, 6, 11, and 16. Such amendments were entered because a July 8, 2005 Office Action withdrew the finality of the February 8, 2005 Office Action, and made the July 8, 2005 Office Action "final."

Earlier history is that the subject application was filed March 31, 2001 and set forth original claims 1-20, with claims 1, 6, 11 and 16 being in independent form. Claims 6, 10, 11, 15, and 16 were amended and claims 21-22 were newly presented in an Amendment filed September 13, 2004.

v. **SUMMARY OF CLAIMED SUBJECT MATTER:**

A first exemplary embodiment of the present subject matter, as set forth in independent claim 1, corresponds to a system for providing object to object communication. Such object to object communication system may be provided in terms of hardware architecture as illustrated in Fig. 2 of the subject application. Software stored in memory 23 may include one or more separate programs, each of which comprises an ordered listing of executable instructions for implementing logical functions. (See pg. 6 lines 10-24 of the original specification.) In the exemplary embodiment of claim 1, the object to object communication systems comprises the software stored in memory 23 which also stores a component framework 27 and a suitable operating system (O/S) 26.

The object to object system 30 may be a source program, executable program (object code), script, or any other entity comprising a set of instructions to be performed. When the object to object system 30 is implemented as a source program, then the program is usually translated via a compiler, assembler, or the like which may or may not be included within the memory 23. Furthermore, the object to object system 30 can be written as: (a) an object oriented programming language, which has classes of data and methods, or (b) a procedure programming language, which has routines, subroutines, and/or functions, for example but not limited to, C, C++, Pascal, BASIC, FORTRAN, COBOL, Perl, Java, and Ada.

A second exemplary embodiment of the present subject matter, as set forth in independent claim 6, corresponds to a method for providing object to object

communication. Such object to object communication methodology may be provided in terms of the process flow as illustrated in Fig. 5 of the subject application.

The method for providing object to object communication may be provided as follows: First, the object to object communication system is initialized. Next, the object to object communications systems identifies the objects to communicate. Then the objects to communicate are located. Following location of the objects to communicate, it is determined whether the objects are in different components. If the objects to communicate are in different components, the object to object communications system uses wrapper facades to encode the information to facilitate the object to object communication. If the objects are not in different components, or if after encoding of the information the objects are in different components, object to object communication is performed. (See the material bridging pages 14 and 15 of the original specification, starting at page 14, line 14.)

A third exemplary embodiment of the present subject matter, as set forth in independent claim 11, corresponds to a computer readable medium for providing object to object communication. Such a computer-readable medium may correspond to or be incorporated within memory 23 as illustrated in Fig. 2 of the subject application. Software stored in memory 23 may include one or more separate programs, each of which comprises an ordered listing of executable instructions for implementing logical functions. (See pg. 6 lines 10-24 of the original specification.) In the exemplary embodiment of claim 11, the computer-readable medium particularly includes logic for identifying at least two objects from a plurality of objects to communicate, logic for locating the at least two objects to communicate within a computer system that exists

across multiple distinct servers, and logic for using a component framework to enable the communication of the at least two objects. It should be noted that the object to object communications system can be stored on virtually any computer readable medium for use by or in connection with any instruction execution system, apparatus, or device, such as a computer-based system, processor-containing system, or other system that can fetch the instructions from the instruction execution system, apparatus, or device and execute the instructions. The computer readable medium can be, for example but not limited to, an electronic, magnetic, optical, electromagnetic, infrared, or semiconductor system, apparatus, device or propagation medium. More specific examples (a non-exhaustive list) of the computer-readable medium would include the following: an electrical connection having one or more wires, a portable computer diskette, a random access memory (RAM), a read-only memory (ROM), an erasable programmable read-only memory (EPROM, EEPROM, or Flash memory), an optical fiber, and a portable compact disc read-only memory (CDROM). The computer-readable medium could even be paper or another suitable medium upon which a program is printed, as the program can be electronically captured, via for instance optical scanning of the paper or other medium, then compiled, interpreted or otherwise processed in a suitable manner if necessary, and then stored in a computer memory.

Another exemplary embodiment of the present subject matter, as set forth in independent claim 16, corresponds to a system for providing object to object communication particularly including such elements as an identifier, a locator, and a component framework existing across multiple servers. As illustrated in Figs. 2, 3 and 4, such present mechanisms and others that combine to provide object to object

communication in accordance with the present technology may be embodied within memory 23. It should be appreciated that the servers may reside in the same local computer or on remote computers. (See pg. 10, lines 1-2 of the original specification).

vi. **GROUND OF REJECTION TO BE REVIEWED ON APPEAL:**

- I. Are claims 1-4, 6-9, 11-14, 16-19, 21, and 22 unpatentable under 35 U.S.C. §103(a) as being unpatentable over the article by Schmidt ("Wrapper Façade – A Structural Pattern for Encapsulating Functions within Classes") in view of U.S. Patent No. 5,544,320 (Konrad)?
- II. Are claims 5, 10, 15, and 20 unpatentable under 35 U.S.C. §103(a) over the article by Schmidt ("Wrapper Façade – A Structural Pattern for Encapsulating Functions within Classes") in view of U.S. Patent No. 5,544,320 (Konrad) and further in view of U.S. Patent 5,732,270 (Foody et al.)?

vii. **ARGUMENT:**

- I. Claims 1-4, 6-9, 11-14, 16-19, 21, and 22 are not obvious under 35 U.S.C. §103(a) over Schmidt in view of U.S. Patent No. 5,544,320 (Konrad).

Before setting forth a discussion of the referenced allegedly rejection grounds, it is respectfully submitted that controlling case law has frequently addressed rejections under Section 103. In addition to the well-known required multi-step analysis of

Graham v. John Deere Co., 381 U.S. 1, 148 U.S.P.Q. 459 (S. Ct. 1966), and its progeny, the Court of Appeals for the Federal Circuit has on numerous occasions offered its guidance concerning the propriety of Section 103 rejections.

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so¹. (emphasis original)

The task of the Patent Office is essentially a burden of proof not just to show prior patents with selected elements similar to respective parts of a claimed combination, but to show teachings to support obviously combining the elements in the manner claimed.

Virtually all inventions are necessarily combinations of old elements. The notion, therefore, that combination claims can be declared invalid merely upon finding similar elements in separate prior patents would necessarily destroy virtually all patents and cannot be the law under the statute, ' 103.² (footnotes omitted)

In In re Deminski, 230 U.S.P.Q. 313 (Fed. Cir. 1986), the court reversed a Patent Office Board of Appeals decision rejecting claims for obviousness, saying: "There [was] nothing in the prior art references, singly or in combination, 'to suggest the desirability, and thus the obviousness' of the [claimed subject matter]." Id. at 315; emphasis original. The court noted that the relied-on reference did not address the technical problem addressed by the claimed invention (and in fact taught away from the Applicant's invention), and stated the well-established principle that "[h]indsight analysis is clearly improper. . . ." Id. at 316.

¹ ACS Hospital Systems, Inc. v. Montefiore Hospital, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

In Bausch & Lomb v. Barnes-Hind/Hydrocurve, 230 U.S.P.Q. 416 (Fed. Cir. 1986), the court vacated a district court holding of invalidity for obviousness. In doing so, the district court was criticized for viewing teachings from the prior art in isolation, instead of considering the prior art references in their entirety; for entering the tempting but forbidden zone of hindsight analysis; for failing to view the claimed invention as a whole; and for disregarding express claim limitations. Id. at 419, 420.

It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art³. (emphasis added)

The Supreme Court in Graham and Adams . . . foreclosed the use of substitutes for facts in determining obviousness under section 103. The legal conclusion of obviousness must be supported by facts. [footnote omitted] Where the legal conclusion is not supported by facts, it cannot stand. . . .

A rejection based on section 103 clearly must rest on a factual basis, and these facts must be interpreted without hindsight reconstruction of the invention from the prior art. . . . It [the Patent Office] may not, because it may doubt that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis. . . .

[W]e may not resolve doubts in favor of the Patent Office determination when there are deficiencies in the record as to the necessary factual bases supporting its legal conclusion of obviousness⁴. (emphasis original)

2 Panduit Corp. v. Dennison Manufacturing Co., 1 U.S.P.Q. 2d 1593, 1603 (Fed. Cir. 1987).

3 Bausch & Lomb v. Barnes-Hind/Hydrocurve, 230 U.S.P.Q. 416, 419 (Fed. Cir. 1986).

4 In re Warner, 379 F.2d 1011, ___, 154 U.S.P.Q. 173, 177, 178 (C.C.P.A. 1967).

Finally, the PTO Board of Appeals noted the following in Ex parte Clapp:
"[S]implicity and hindsight are not proper criteria for resolving the issue of obviousness."⁵

The following analysis of the present rejection is respectfully offered with guidance from the foregoing controlling case law decisions.

In view of the significant distinctions discussed herein, Applicant respectfully traverses the listed grounds of rejection.

By relying on rejection grounds under 35 U.S.C. §103(a) for alleged obviousness, and by various statements throughout the subject Office Action, the PTO already acknowledges certain important deficiencies of the Schmidt reference which renders such reference inadequate for serving by itself (without some external motivation or suggestion to modify) as a rejection basis for claims 1-4, 6-9, 11-14, 16-19, 21, and 22.

Numbered page 2 of the July 8, 2005 Office Action alleges that:

"... Schmidt teaches a system for providing object to object communications (client-server communications), comprising:

means for identifying at least two objects (one being the client and one being database/printer service) from a plurality of objects (client, database, printer, console services/functions) to communicate (invoke / request services)...;

means for locating the at least two objects to communicate (socket handles)...;
and

⁵ Ex parte Clapp, 227 U.S.P.Q. 972, 973 (PTO Bd. App. 1985).

means for using a component framework (wrapper façade implemented as frameworks such as ACE) to enable the communications (forward client invocations) of the at least two objects”

The subject Office Action in the material bridging at numbered pages 2 – 3 further takes the position that:

“An object is a client to one object and is a server to another object. Such configuration is taught by Konrad who teaches an entity (host 106a including remote object client 114) and is a server to another object (host 104 including human interface 110 to accept user input). ... Given the teaching of Konrad, it would have been obvious to include both client and server functionalities into each of the client entities of Schmidt.”

Applicants respectfully disagree with such assertions.

One of the most basic concepts embodied in each of the subject independent claims resides in the concept of providing a mechanism whereby communications may be established between at least two objects residing on multiple separate servers.

The subject Office Action acknowledges that Schmidt fails to disclose separate or multiple servers and seeks to remedy such significant deficiency by citing Konrad. Further, such Office Action seeks to employ the concepts disclosed in Konrad as justification for interpreting objects as functioning as both a server **and** a client with other objects. Thus, the subject Office Action states in pertinent part at numbered page 3 thereof:

“When the teachings are combined, a client machine of Schmidt would have behaved as both a client machine/host and a server machine/host, and therefore the

two communicating objects would have been located on separate and distinct server locations/machines.”

As a preliminary matter, even assuming, *arguendo*, that such an analogy was valid, a proposition with which Applicants do not agree, such combination would not result in creating a system, method or computer readable medium corresponding to the presently claimed subject matter. Each of the independent claims plainly recites subject matter wherein at least two objects that reside on separate servers are sought out for communications. **Applicants are not claiming that their system, method or computer readable medium provides objects that “act like” both servers and clients, but rather that there are objects residing on servers.**

Applicants have hereinabove outlined the well known requirements necessary to establish obviousness through alleged combination of references. Such requirements include the concept of “modifying” the base reference in light of the teachings of a secondary reference so that the combined teachings will render obvious the claimed subject matter. The subject Office Action seeks not to modify the base reference but rather to re-define the term “objects” in a way so that the presence of separate servers as claimed may be established through such new definition.

Applicants submit, however, that in order to satisfy the requirements of 35 U.S.C. §103(a), motivation must be established for making modifications of a base reference through teachings outside the base reference. As such, based on the presently claimed subject matter, 35 U.S.C. §103(a) would require that references and motivation be provided to show, at a minimum, that it would be obvious to add at least one more server to Schmidt, not that it would be “obvious” to re-define the role of an object as

“functioning” as a server and client simultaneously. The practice of redefining an object so that it “functions” as both a client and a server is simply not the same as providing objects residing on servers.

In sum, Schmidt and Konrad fail to disclose, singularly or in combination, all elements of present independent claims 1, 6, 11 and 16, wherefore such claims are not obvious under 35 U.S.C. §103(a) over such references. Furthermore, since claims 2-5, 7-10, 12-15 and 17-22 variously depend from otherwise patentable independent claims 1, 6, 11 and 16 and further limit same, all claims 1-22 are patentable over such alleged combination of references.

- II. Claims 5, 10, 15, and 20 are not obvious under 35 U.S.C. §103(a) over Schmidt in view of U.S. Patent No. 5,544,320 (Konrad) and further in view of U.S. Patent 5,732,270 (Foody et al.).

Based on the distinctions noted hereinabove with respect to the proposed combination of Schmidt in view of Konrad, Applicants respectfully submit that claims 5, 10, 15, and 20 as they depend from allowable claims, are themselves allowable even considering Foody et al.

The subject Office Action, middle of numbered page 4, notes that “Schmidt does not teach translation from one view to another view.” Such admitted deficiency is sought to be supplied by Foody et al. Respectfully, the particular claims at issue relative to the above-noted citation of Foody et al. all affirmatively recite (emphasis added) “a translation from one view to another view if the at least two objects are

address classes.” The subject Office Action does not address at all such affirmative limitation of the claims, but instead concludes (on numbered page 4):

“Given the teachings of Foody, it would have been obvious to include into Schmidt translation from one view to another view. One of ordinary skill in the art would have been motivated to combine the teachings of Schmidt and Foody because this would have provided bi-directional interoperability ... wherein a client desires both to send a request to and to receive a response from heterogeneous services such as database and printing.”

Respectfully, such statement regarding combination and alleged motivation does not address the issue of limiting the translation from one view to another if the at least two objects are address classes, as specifically recited in each of the subject pending claims. Moreover, Schmidt already provides all the bi-directional interoperability he needs via the single server and multiple client system he provides. There simply is no reason to add something (bi-directional operability) to a system that already exists.

Based on the above remarks, Applicants respectfully submit that claims 5, 10, 15, and 20 are patentable over the proposed combination of Schmidt in view of Konrad and further in view of Foody et al.

Reversal of all the foregoing grounds of rejection, and allowance for pending claims 1 through 22 is respectfully requested.

Respectfully submitted,

DORITY & MANNING,
ATTORNEYS AT LAW, P.A.

April 6, 2006
Date

A handwritten signature in black ink, reading "Richard M. Moose". The signature is written in a cursive style with a large, looping initial "R".

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viii. **CLAIMS APPENDIX**

In accordance with 37 C.F.R. §1.121, the claim listing below includes the status and text of all claims.

1. (Previously Presented) A system for providing object to object communication, comprising:
 - means for identifying at least two objects in separate and distinct server locations from a plurality of objects to communicate;
 - means for locating the at least two objects to communicate; and
 - means for using a component framework to enable the communication of the at least two objects.
2. (Original) The system of claim 1, further comprising:
 - means for determining if the at least two objects are within different components.
3. (Original) The system of claim 2, further comprising:
 - means for using a wrapper facade to enable the communication of the at least two objects if the at least two objects are within different components.
4. (Original) The system of claim 1, further comprising:
 - means for determining if the at least two objects are address classes.
5. (Original) The system of claim 4, further comprising:
 - means for employing a translation from one view to another view if the at least two objects are address classes.
6. (Previously Presented) A method for providing object to object communication, said method comprising steps of:

identifying at least two objects from a plurality of objects to communicate;
locating the at least two objects to communicate; and
using a component framework to enable the communication of the at least two objects, wherein said component framework exists across multiple distinct servers.

7. (Original) The method of claim 6, further comprising the step of:
determining if the at least two objects are within different components.

8. (Original) The method of claim 7, further comprising the step of:
using a facade wrapper to enable the communication of the at least two objects if
the at least two objects are within different components.

9. (Original) The method of claim 6, further comprising the step of:
determining if the at least two objects are address classes.

10. (Previously Presented) The method of claim 9, further comprising the step
of:
employing a translation from one view to another view if the at least two objects
are address classes.

11. (Previously Presented) A computer readable medium for providing object
to object communication, comprising:

logic for identifying at least two objects from a plurality of objects to
communicate;

logic for locating the at least two objects to communicate within a computer
system that exists across multiple distinct servers;

logic for using a component framework to enable the communication of the at
least two objects.

12. (Original) The computer readable medium of claim 11, further comprising:
logic for determining if the at least two objects are within different components.
13. (Original) The computer readable medium of claim 12, further comprising:
logic for using a wrapper facade to enable the communication of the at least two
objects if the at least two objects are within different components.
14. (Original) The computer readable medium of claim 11, further comprising:
logic for determining if the at least two objects are address classes.
15. (Previously Presented) The computer readable medium of claim 14,
further comprising:
logic for employing a translation from one view to another view if the at least two
objects are address classes.
16. (Previously Presented) A system for providing object to object
communication, comprising:
an identifier that identifies at least two objects from a plurality of objects to
communicate;
a locator that locates the at least two objects to communicate; and
a component framework that enables the communication of the at least two
objects, wherein said component framework exists across multiple servers.
17. (Original) The system of claim 16, wherein the locator determines if the at
least two objects are within different components.
18. (Previously Presented) The system of claim 17, further comprising:
a wrapper facade that enables the communication of the at least two objects if
the at least two objects are within different components.

19. (Original) The system of claim 16, wherein the locator determines if the at least two objects are address classes.

20. (Original) The system of claim 19, further comprising:
a translator that translates from one view to another view if the at least two objects are address classes.

21. (Previously Presented) The system of claim 16, wherein said at least two objects are located in separate and distinct server locations.

22. (Previously Presented) The system of claim 16, wherein the communication of the at least two objects via said component framework is effected via a common object request broker architecture (CORBA) communication standard.

ix. **EVIDENCE APPENDIX**

Not Applicable

x. **RELATED PROCEEDINGS APPENDIX**

Not Applicable